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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
LEE, TOMMY D	
ART UNIT	PAPER NUMBER
2624	

DATE MAILED: 06/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/977,847

Applicant(s)

CHENG, STONE

Examiner

Thomas D. Lee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 11-20 is/are rejected.
- 7) ☒ Claim(s) 10 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-3 and 11-13 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 4,837,635 (Santos).

Santos discloses an operating procedure of a scanning system which gets image automatically, said operating procedure comprising: scanning an original to get an image, wherein said image displays all content of said original (column 2, lines 27-30); displaying said image (column 2, lines 59-62); receiving a portion of said image which is selected by the user (column 2, lines 62-64); and outputting said portion of said image which is selected by the user (column 2, lines 64-66). The operating procedure further comprises: receiving a scanning parameter (column 2, lines 30-36); scanning said original based on said scanning parameter to get said image (column 2, lines 45-58), wherein said scanning parameter comprises a resolution for scanning said original (column 2, line 33); scanning an original to get an image (column 2, lines 27-30); proceeding an image processing procedure to treat said image before displaying said image (column 2, lines 30-36 (scan parameters (1)-(5) inherently involve image processing to some extent)), wherein said image processing procedure can be modified, replaced, and upgraded by the user (column 2, lines 36-40 (some scan

parameters user-determined)); modifying said portion of said image which is selected by the user (reduction or enlargement (column 2, lines 66-67; column 4, lines 22-34)); and outputting said image after modification (column 4, lines 22-23).

3. Claims 14 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 5,136,399 (Aoyama).

Regarding claim 14, Aoyama discloses a method for using a scanning system with one-scan-and-done feature and free of identifying original's attribute, said method comprising: using a scanning system to scan an original to get an image (column 6, lines 20-29); receiving said image which display all content of said original (column 7, lines 29-32); selecting a portion of said image (column 7, lines 32-66); modifying said portion of said image (column 8, lines 1-7); and outputting said portion of said image (column 5, lines 48-49 (to-be-made copy indicates presence of a printer)).

Regarding claim 19, Aoyama discloses a scanning system with one-scan-and-done feature and free of identifying original's attribute, said scanning system comprising: a scanning module for scanning an original to get an image which display all content of said original (IIT 12 (Fig. 2)); a processing module for processing said image which pass through by scanning module (IPS 13); a storing module for storing said image (document memory 16); a display module for displaying said image (display unit 22); a receiving module for receiving a portion of said image which is selected by the user, and also receiving an image-modification command which is sent by the user and used to modify said image wherein said image-modification command will be sent to processing module to modify said image, and using said storing module to store said

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image after modification (display controller 21); and an outputting module for outputting said image which is stored in said storing module (to-be-made copy, as mentioned above, indicates presence of a printer).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 4-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Santos as applied to claim 1 above, and further in view of U.S. Patent 6,256,117 (Hsu et al.).

Regarding claim 4, Santos does not provide both a reflective scanning mode and a transparent scanning mode for scanning said original. Hsu et al. disclose a transmissive/reflective scanning device (Abstract) that pre-scans an original in the transmissive scanning mode, and then scans the original in either the same mode or the reflective scanning mode, according to the results of the pre-scan (column 3, lines 4-65). Hsu et al. state that present scanners are typically required to provide more and more functions, and that today's scanners use both transmissive and reflective modes for scanning originals (column 1, lines 12-15). In view of Hsu et al., it would have been obvious for one of ordinary skill in the art to provide the scanning system of Santos with both transmissive and reflective modes, so that more types of originals may be scanned to provide an output image, thereby increasing the system's flexibility.

Regarding claims 5 and 6, the operating procedure disclosed in Hsu et al. further comprises: scanning said original with a reflective scanning mode to get a reflective image (column 4, lines 6-7); analyzing said reflective image (column 4, lines 8-16); scanning said original with a transparent scanning mode to get a transparent image while said reflective image only displays a portion of said original (column 4, lines 14-16 (average gray scale less than critical value, indicating missing portions in the scanning in reflective mode), lines 20-23; while display of scanned image not explicitly disclosed in Hsu et al., the display of a scanned image is notoriously well known (note Fig. 6 of Santos)); and displaying said reflective image directly while said reflective image displaying all content of said original (column 4, lines 17-20).

Regarding claims 7-9, the operating procedure disclosed in Hsu et al. further comprises: scanning said original with a transparent scanning mode to get a transparent image (column 3, lines 15-28); analyzing said transparent image (column 3, lines 29-44); scanning said original with a reflective scanning mode to get a reflective image while said transparent image only displays a portion of said original (column 3, lines 40-41 (average gray scale less than critical value, indicating missing portions in the scanning in transmissive mode), lines 59-65; while display of scanned image not explicitly disclosed in Hsu et al., the display of a scanned image is disclosed in Santos (Figs. 6 and 7)); and displaying said transparent image directly while said transparent image displaying all content of said original (Hsu et al., at column 3, lines 47-59). The separate display of transparent and reflective portions of an image, while not explicitly disclosed in Hsu et al., would have been an obvious modification of Hsu et al., because

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one of ordinary skill in the art would have recognized the fact that where there are different sections of an image, each section must be individually examined to determine whether the section is transparent or reflective.

6. Claims 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aoyama as applied to claim 14 above, and further in view of Hsu et al.

Regarding claim 17, Aoyama does not provide both a reflective scanning mode and a transparent scanning mode for scanning said original. As mentioned above, Hsu et al. disclose a transmissive/reflective scanning device (Abstract) that pre-scans an original in the transmissive scanning mode, and then scans the original in either the same mode or the reflective scanning mode, according to the results of the pre-scan (column 3, lines 4-65). Hsu et al. state that present scanners are typically required to provide more and more functions, and that today's scanners use both transmissive and reflective modes for scanning originals (column 1, lines 12-15). In view of Hsu et al., it would have been obvious for one of ordinary skill in the art to provide the scanning system of Aoyama with both transmissive and reflective modes, so that more types of originals may be scanned to provide an output image, thereby increasing the system's flexibility.

Regarding claim 18, Hsu et al. further discloses scanning to get said image which displays all content of said original with one of said scanning modes, wherein said scanning system won't perform scanning again with another scanning mode (column 3, lines 47-59; column 4, lines 17-20).

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7. Claims 15, 16 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aoyama as applied to claims 14 or 19 above, and further in view of Santos.

Aoyama does not appear to disclose user input of a scanning parameter to make the said scanning system perform scanning based on said scanning parameter, wherein said scanning parameter includes an image process command that is used to execute an image process procedure after said original is scanned, and before said image is displayed. Santo discloses these limitations (column 2, lines 30-41 (scan parameters (1)-(5) inherently involve image processing to some extent)). By providing a means for enabling a user to input scanning parameters for previewing a scanned image, the user is better able to control the appearance of the displayed image according to his or her preferences. Therefore, it would have been obvious for one of ordinary skill in the art to modify the teaching of Aoyama by providing user input of scanning parameters, such as disclosed in Santos.

Allowable Subject Matter

8. Claim 10 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

9. The following is a statement of reasons for the indication of allowable subject matter: No prior art has been found to disclose or suggest substitution of a portion not presented by said transparent image by said reflective image, and substitution of a portion not presented by said reflective image by said transparent image.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas D. Lee whose telephone number is (571) 272-7436. The examiner can normally be reached on Monday-Friday (7:30-5:00), alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on (571) 272-7437. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Thomas D. Lee
Primary Examiner
Art Unit 2624

tdl
June 13, 2005